

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
Serial No.: 09/993,731
Filing Date: November 13, 2001
Page 5

REMARKS

Claims 1, 2, 4-10 and 12-15 are pending in the instant application. Claims 1, 2, 4-10 and 12-15 have been rejected. Claim 1 has been amended. No new matter has been added by these amendments to the claims. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims Under 35 U.S.C. 102

Claims 1 and 2 have been rejected under 35 U.S.C. 102(e) as being anticipated by Crouzet et al. (US Patent No. 6,319,672). The Examiner suggests that this patent discloses an oligonucleotide that corresponds with a region of the nucleotides 1771 through 1792 of the instant SEQ ID NO: 10 and that the disclosed oligonucleotide meets the structural limitations of the claims. Applicants respectfully traverse this rejection.

At the outset, Applicants have amended the claims to recite antisense compounds targeted to a specific nucleobase region within the sequence of a specific form of inhibitor-kappa B-R (SEQ ID NO: 10). Support for this amendment to the claims can be found throughout the specification as filed but in particular at pages 80-84, Table 1, where a region starting at nucleobase 1182

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
Serial No.: 09/993,731
Filing Date: November 13, 2001
Page 6

is found and continues through nucleobases 1433 with no large gaps.

Crouzet et al. (U.S. Patent No. 6,319,672 B1) disclose a method for double-stranded DNA purification and in the patent disclose as well a single oligonucleotide that overlaps with a section of the coding region of SEQ ID NO: 10. No antisense compounds are taught or suggested by this reference, including those targeted to a specific region within the sequence of SEQ ID NO: 10 as now claimed. In order to anticipate an invention, the cited reference must teach each and every limitation of the claims (MPEP 2131). The cited reference fails to teach the limitations of the claims as amended. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1, 2, 4-10 and 12-14 have been rejected under 35 U.S.C. 102(e) and 102(a) as being anticipated by Dean et al. (U.S. Patent No. 6,180,353). The Examiner suggests that this reference discloses and claims an antisense oligonucleotide that corresponds with a region of nucleotides 1756 through 1771 of SEQ ID NO: 10 and that this oligonucleotide meets the structural requirements of the claims. Applicants respectfully traverse this rejection.

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
Serial No.: 09/993,731
Filing Date: November 13, 2001
Page 7

Dean et al. (U.S. Patent No. 6,180,353 B1) disclose antisense compounds targeted to DAXX and inhibition of expression of this gene. The patent also discloses a single antisense compound that overlaps with a portion of the coding region of SEQ ID NO: 10. No other antisense compounds that overlap with any part of the claimed sequence are taught or suggested by this reference, including none targeted to specific regions within the sequence of SEQ ID NO: 10 as now claimed. In order to anticipate an invention, the cited reference must teach each and every limitation of the claims (MPEP 2131). The cited reference fails to teach the limitations of the claims as filed. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1, 2, 4-10 and 12-14 have been rejected under 35 U.S.C. 102(e) as being anticipated by McKay et al. (U.S. Patent No. 6,455,307). The Examiner suggests that this patent discloses an antisense oligonucleotide that corresponds to a part of the coding region, namely nucleotides 1881 through 1898 and that would inherently meet all the structural requirements and limitations of the claimed compounds. Applicants respectfully traverse this rejection.

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
Serial No.: 09/993,731
Filing Date: November 13, 2001
Page 8

McKay et al. (U.S. Patent No. 6,455,307) disclose antisense modulation of casein kinase 2-alpha prime expression. The patent discloses one antisense oligonucleotide that overlaps a portion of the coding region of SEQ ID NO: 10 of the instant application. No other antisense compounds that overlap with any part of the claimed sequence are taught or suggested by this reference, including none targeted to specific regions within the sequence of SEQ ID NO: 10 as now claimed. In order to anticipate an invention, the cited reference must teach each and every limitation of the claims (MPEP 2131). The cited reference fails to teach the limitations of the claims as filed. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims Under 35 U.S.C. 103(a)

Claims 1, 2, 4-10 and 12-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (2000) in view of Monia et al. (US Patent 5,977,341) and Monia et al. (US Patent 6,395,545), and Applicants admission on page 80 of the specification as filed. The Examiner suggests it would have been *prima facie* obvious for one of ordinary skill in the art to make antisense targeted to inhibitor-kappa B-R since it has been

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
Serial No.: 09/993,731
Filing Date: November 13, 2001
Page 9

taught in the art that this gene is involved in the NfκB pathway and both of the references of Monia et al. teach use of antisense to elucidate the function of members of this pathway, while the sequence of the inhibitor-kappa B-R gene is taught by Norman et al., and SEQ ID NO: 10 was from a published document as cited in the instant specification. The Examiner suggests that since the art has shown the successful use of antisense with members of the overall pathway that it would have been obvious to use antisense to test the properties of a new pathway member. Applicants respectfully disagree with the Examiner's suggestion regarding this combination of art.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest all claim limitations.

As discussed *supra*, and as acknowledged by the Examiner, the primary reference of Norman et al. (2000) fails to teach

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
Serial No.: 09/993,731
Filing Date: November 13, 2001
Page 10

antisense oligonucleotides targeted to inhibitor-kappa B-R. The secondary references cited by the Examiner also fail to teach antisense compounds targeted to the specific gene claimed, inhibitor-kappa B-R, a point that is also acknowledged by the Examiner. Therefore, the limitations of the claims as filed and as now amended, which specify a specific nucleobase region within the sequence of inhibitor-kappa B-R (SEQ ID NO: 10) to be targeted by antisense compounds, are not taught or suggested by any of the references individually or when combined. Therefore, the limitations of the claims as amended clearly are not taught or suggested by the combination of prior art references, nor is any expectation of successful use of such antisense compounds provided by the combination of prior art. It is only with the specification in hand that one of skill would understand that a specific region of inhibitor-kappa B-R as claimed could be targeted successfully with antisense compounds. The teaching of antisense to an entirely different gene, even though it is a related gene, would not assure one of skill in the art that antisense would be successfully used. Thus, the combination of prior art cited cannot render the instant claimed invention

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
Serial No.: 09/993,731
Filing Date: November 13, 2001
Page 11

obvious. Withdrawal of this rejection is therefore respectfully requested.

III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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